

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JAMES R. GROSS

---

Appeal No. 97-3290  
Application 08/465,896<sup>1</sup>

---

ON BRIEF

---

Before COHEN, JOHN D. SMITH and PATE, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21 through 35. These claims constitute all of the claims remaining in the application.

---

<sup>1</sup> Application for patent filed June 6, 1995. According to appellant, the application is a division of Application 08/164,112, filed December 7, 1993, now abandoned, which is a continuation-in-part of Application 07/858,477, filed March 27, 1992, now abandoned.

Appeal No. 97-3290  
Application 08/465,896

Appellant's invention pertains to a disposable absorbent product for absorbing a body fluid. An understanding of the invention can be derived from a reading of exemplary claim 21, a copy of which can be found in the "Appendix" to the brief (Paper No. 11).

The following rejections are before us for review.

Claims 21 through 35 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which fails to enable the breadth of the claims.

Claims 21 through 35 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the final rejection and answer (Paper Nos. 6 and 12), while the complete statement of appellant's argument can be found in the brief (Paper No. 11).

Appeal No. 97-3290  
Application 08/465,896

In the brief (page 2), appellant indicates, in effect, that as to the claims in each of the rejections on appeal, they stand or fall as a group. Accordingly, in our analysis, infra, we shall focus exclusively upon selected independent claim 21;  
37 CFR 1.192(c)(7).

#### OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification, drawing Figs. 1 and 2, claim 21, and the respective viewpoints of appellant and the examiner.<sup>2</sup> As a consequence of our review, we make the determinations which follow.

---

<sup>2</sup> We note the presence in the application file of an "INFORMATION DISCLOSURE STATEMENT" (Paper No. 3) and a "SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT" (Paper No. 7), each of which should be given appropriate review upon any further prosecution before the examiner.

Appeal No. 97-3290  
Application 08/465,896

Initially, we note that in a situation such as the present one, wherein claims are rejected under both the first and second paragraphs of 35 U.S.C. § 112, the definiteness of the claims are

addressed prior to an analysis of whether the claimed subject matter is supported by an enabling disclosure. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Accordingly, at the outset, we determine that claim 21, considered as a whole, is indefinite, for reasons articulated, infra. However, following the pattern of the examiner and appellant in discussing the first paragraph issue first and the indefiniteness issue second, we likewise turn now to the first paragraph issue.

The § 112, first paragraph rejection

We affirm this rejection.

The examiner is of the view (final rejection, page 2 and answer, pages 3 through 5) that claim 21, in particular, is

based upon a specification which fails to enable the breadth of the claim in that certain surfactants within the claimed range would render the claimed disposable absorbent product inoperative (not be effective to reduce odor). From the examiner's standpoint, appellant's "Odor Perception Test" is subjective, and does not establish a standard by which the amount of odor can be measured. Appellant, on the other hand, argues (brief, page 3) that, notwithstanding that certain surfactants having a HLB less than 12 are not suitable for use in the present invention (specification, page 8, line 33 to page 9, line 7), such surfactants are excluded from the claimed invention since such surfactants would not be effective in reducing the odor of urine.

The circumstance that appellant discloses surfactants having a hydrophilic/lipophilic balance less than about 12, as claimed, and which are unsuitable for use in the present invention, does not per se render the claimed invention unpatentable based upon 35 U.S.C. 112, first paragraph. Each case must be assessed on its own facts. See In re Angstadt,

Appeal No. 97-3290  
Application 08/465,896

537 F.2d 498, 503, 190 USPQ 214, 218 (CCPA 1976). If the number of inoperative combinations becomes significant, and in effect forces one of ordinary skill in the art to experiment unduly in order to practice the claimed invention, the claims might indeed be invalid. See Atlas Powder Co. v. E. I. du Pont de Nemours & Co., 750 F.2d 1569, 1576-77, 224 USPQ 409, 414 (Fed. Cir. 1984). An appellant must also demonstrate that any range recited in claims reasonably bounds the area within which satisfactory results could be produced by ordinary design skill, i.e., an appellant must prove that there are embodiments to be found, not only near those specifically disclosed, but at various points throughout the claimed range which would be operative. See In re Cook, 439 F.2d 730, 735, 169 USPQ 298, 302 (CCPA 1971).

In the present case, appellant relies upon an "Odor Perception Test" and a "Surface-Active Agent Effectiveness Test" (specification, page 12) to determine whether a specific surface-active agent is effective to reduce the odor of urine. According to appellant, samples to be tested are provided to a "panel of two specialists" who independently rank the urine-

wet odor of the samples on a scale of 1 (least) to 10 (most) for malodor and intensity. Appellant indicates that samples yielding an odor ranking below about 3.0 possess an odor which would "hardly be noticed by the general public." It is also set forth (specification, page 10) that "[a]s a general rule, the surface-active agent will be present in the absorbent product in an amount of from about 0.005 to about 25 weight percent, based upon total weight of the absorbent structure".

Based upon the information known to us, it is apparent that the tests specified by appellant are not founded upon any industry recognized testing standard for odor level assessment, but instead rely upon the subjective perceptions of a panel of individuals, the individuals being referred to by appellant as "odor specialists". We are not instructed by the disclosure as to the qualifications of those individuals denoted as "odor specialists".<sup>3</sup> The disclosure also does not

---

<sup>3</sup> The specification does not identify the two "odor specialists" (panel) that ran the tests to yield the data disclosed in the application, and does not reveal what training and/or background would certify them as "odor specialists". Distinct from the disclosure of "odor specialists", appellant indicates in the brief (pages 3 and 4) that, in the Surface-Active Agent Effectiveness Test, samples are tested by "odor experts".

inform us as to how it was determined that samples yielding an odor ranking below about 3.0 possess an odor "which would hardly be noticed by the general public".<sup>4</sup>

Taking into full account the particular circumstances of the present case, we believe it both reasonable and fair to say that undue experimentation would be encountered on the part of one having ordinary skill in seeking to determine which surface-active agents having an HLB of less than about 12 were effective to reduce urine odor, as broadly claimed. We reach this conclusion for the following reason. Claim 21 expressly requires a subjective test, a test performed by "odor specialists". Clearly, one of ordinary skill would not have available to them the "odor specialists" referenced by appellant, or knowledge of their particular qualifications, or an appreciation of the personal spectrum of their particular odor perceptions. Lacking this information, it follows that an artisan would be unable to carry out the test required for

---

<sup>4</sup> This determination relative to odor perceptions of the general public is not understood since the brief points out (page 4) that the test procedure does not permit the use of "untrained" individuals.



ascertaining a surface-active agent, i.e., and operable agent, consistent with claim 1. We do not consider it to be reasonable on the part of an artisan to attempt the arduous and uncertain task of seeking to reverse engineer the testing carried out by appellant to see if individuals (a panel of odor specialists) could possibly be found who would also give average results for operable and inoperable agents, as disclosed by appellant (specification, page 9 and Tables 1 through 3). In light of the above, the circumstances of the present case clearly reveal to us that an undue, if not impossible, effort is required for one seeking to practice the present invention, as broadly claimed, notwithstanding appellant's disclosure of certain suitable and unsuitable surface-active agents. Thus, we conclude that the claims on appeal are based upon an underlying disclosure which fails to enable the breadth of the claims.

The argument advanced by appellant (brief, pages 2 and 3) fails to persuade us that the examiner erred in rejecting the claims on appeal under 35 U.S.C. § 112, first paragraph. We appreciate appellant's view that the claims are intended to

Appeal No. 97-3290  
Application 08/465,896

cover surfactants that will work. Nevertheless, as recognized by appellant, the claims require determination of the effective agents based upon the disclosed "Surface-Active Agent Effectiveness Test". As explained above, the requirement of the subjective odor specialist determination, forming an essential part of the test required by claim 21, would not have enabled one of ordinary skill to practice the now claimed invention.

The § 112, second paragraph rejection

We affirm this rejection.

In assessing the indefiniteness issue raised in this appeal, we keep in mind the following principles. Relative to the requirements of 35 U.S.C. § 112, second paragraph, the court in In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970) stated that

[i]ts purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a

patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.

Additionally, claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Independent claim 21 requires, inter alia, an amount of surface effective agent effective to reduce urine odor as determined by the "Surface-Active Agent Effectiveness Test as described herein."<sup>5</sup> This test further encompasses the "Odor Perception Test" (specification, pages 12 and 13).

This panel of the board discussed, supra, the subjective nature of the specified tests and the circumstance that the identity, qualifications, and spectrum of odor perceptions of

---

<sup>5</sup> In our view, one would have understood that the language "as described herein" referred to the description in the underlying specification.

the "odor specialists" were indeterminate. In light of the above, it is quite apparent to us that one having ordinary skill would not be able to determine if a particular surface-active agent was within the scope of the claim. As such, the claims before us are indefinite under 35 U.S.C. § 112, second paragraph, since the metes and bounds thereof are indeterminate when read in light of the underlying specification.

We are not in accord with appellant's viewpoint (brief, page 3) that the claimed subject matter is supported by a disclosed standard, i.e., the Surface-Active Agent Effectiveness Test, for determining whether or not an agent is able to reduce the odor of urine. The test is clearly not a standard, but one based upon the subjective perceptions of "odor specialists". It follows that we also do not share appellant's opinion (brief, page 4) that one skilled in the art would understand what is meant by the surface agent being effective to reduce the odor of urine. This would be so since an agent may or may not be effective to reduce the odor of urine as subjectively assessed by a particular, selected panel

of "odor specialists". Appellant argues (brief, page 4) that, while acknowledged in the specification (page 12) that odor perception is, by nature, a very subjective determination, it is a mischaracterization to infer that the Surface-Active Agent Effectiveness Test is also subjective. We disagree. Since the subjective perceptions of selected "odor specialists" would clearly control determinations made according to the test, we believe it fair to say to that the test is subjective. This panel of the board is aware of appellant's statement (brief, page 4) that many tests relying on perceptions are routinely employed in other industries. However, we fail to comprehend how the indefiniteness discussed above relative to appellant's claimed test is somehow diminished by a broad reference to perceptive testing in other industries.

In summary, this panel of the board has:

affirmed the rejection of claims 21 through 35 under 35 U.S.C. § 112, first paragraph, as being based upon a specification which fails to enable the breadth of the claims;

Appeal No. 97-3290  
Application 08/465,896

and

affirmed the rejection of claims 21 through 35 under  
35 U.S.C. § 112, second paragraph, as being indefinite.

The decision of the examiner is affirmed.

AFFIRMED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	)
	)	
	)	
	)	BOARD OF PATENT
JOHN D. SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	

Appeal No. 97-3290  
Application 08/465,896

ICC/kis

John R. Schenian  
KIMBERLY CLARK CORPORATION  
Patent Department  
401 North Lake Street  
Neenah, WI 54956

Appeal No. 97-3290  
Application 08/465,896